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Docket No: LE9-00-045

PATENT

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Donna S. Bruce

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant:	Sherry A. Cook et al.	:		
Serial No.:	09/610,081	:	Group Art Unit:	2624
Filed:	July 5, 2000	:	Examiner:	K. Poon

For: **Printer Apparatus With Integrated Graphical User Interface and Method for Using the Same** :

APPEAL BRIEF

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

The present Appeal Brief is submitted in support of the Notice of Appeal filed by Certificate of Mail on July 31, 2002 and received by the U.S. Patent and Trademark Office on August 5, 2002.

I. REAL PARTY IN INTEREST

The real party in interest in this Appeal is the assignee of the present application, Lexmark International, Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Appellants, the Appellants' undersigned legal representative or the assignee which will directly effect

or be directly effected by or having a bearing on the Board's decision in the present appeal. While the assignee believes there are no other appeals which will directly effect or be directly affected by or have a bearing on the Board's decision, the following applications of the assignee relating to stand-alone printers are also under appeal: 09/610,129; 09/609,891; 09/610,404 and 09/610,249.

III. STATUS OF THE CLAIMS

Claims 1-4 and 6-22 are pending. Claims 1-4 and 6-22 stand rejected. A copy of the pending claims is set forth in the Appendix.

IV. STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION

No Amendments have been filed subsequent to final rejection.

V. SUMMARY OF THE INVENTION

The claimed invention is directed to stand-alone printing apparatuses adapted to print digital photographs and methods for using the same (page 1, lines 2-4 of the specification).

As set forth in independent claim 1, a claimed stand-alone printing apparatus for transferring one or more digital photographs captured by a digital device to a printable medium comprises: an input member for receiving the one or more digital photographs from a source; an image processor for generating an image corresponding to each digital photograph; an integrated graphical user interface with a video display for displaying the images and for selecting one or more of the digital photographs for a printed page; at least one drive for receiving a computer-readable medium, wherein the source is a computer-readable medium disposed in the drive; and a print control for producing on the printable medium a pattern associated with the printed page (page 4, lines 13-24 and page 9, lines 11-25 of the specification).

Claims 2-4 and 6-11 are each dependent upon claim 1 and further define the stand-alone printing apparatus. In claim 2, the image processor of the stand-alone printing apparatus formats the images in response to user instructions from the user interface, and the user interface updates the video display to reflect the formatted images (page 11, lines 1-6 of the specification). In claim 3, the user interface is defined as including an operator panel having a plurality of activating members for initiating instructions to the user interface. The video display is located on the operator panel (page 11, lines 23-27 of the specification).

Claims 4 and 6 are each dependent upon claim 3. As defined by claim 4, the video display is a color liquid-crystal display (page 12, lines 2-6 of the specification). In claim 6, the user interface is defined as including a plurality of different states. The video display varies between the different states (page 12, lines 17-26 of the specification). As defined by claim 7, which is dependent on claim 6, the different states include an image view, in which an image is depicted on the display, and a page view in which a page is depicted on the display (page 12, lines 21-26 of the specification).

Claims 8-11 are each dependent upon claim 7. As defined by claim 8, the page includes one or more digital photographs selected during the image view (page 12, lines 26-28 of the specification). As defined by claim 9, activation of a print button in the image view instructs the print control to produce a pattern on the printable medium corresponding to an image on the video display (page 15, lines 1-8 of the specification). In claim 10, the different states are defined as including a device view in which a representation of the printing apparatus, as well as any attached devices, is depicted on the video display (page 13, lines 4-6 of the specification). Claim 11 defines the user interface as including a set of options associated with each

of the different states, and wherein the options associated with a particular state may be displayed and selected while the particular state is active on the video display (page 13, lines 25 – page 14, line 14 of the specification).

As set forth in claim 12, a claimed graphical user interface for a stand-alone photoprinter capable of transferring a digital photograph from a source to a printable medium comprises: a video display integrated within the photoprinter for graphically depicting an image corresponding to the digital photograph; a plurality of activating members for initiating user instructions to the user interface; as well as a plurality of different states in which to depict information on the video display, one of the states being active at a time. The user interface moves between active states in response to activation of one or more of the activating members (page 4, line 25 – page 5, line 4 of the specification).

Claims 13-17 are each dependent upon claim 12 and further define the graphical user interface. Claim 13 defines the different states as including an image view in which an image corresponding to a digital photograph is depicted on the video display, and a page view in which a page comprised of selected images is depicted on the video display (page 12, lines 21-26 of the specification). Claims 14-16 are each dependent upon claim 13.

As defined by claim 14, the different states include a device view in which a graphical representation of the photoprinter, as well as any attached devices, is depicted on the video display (page 13, lines 4-6 of the specification). Claim 15 defines the user interface as including formatting options for formatting the digital photograph. The user interface formats the digital photograph in response to user instructions as well as updates the image on the video display with a formatted image (page 10, lines 19-29 and page 11, lines 1-6 of the specification). In claim 16, the

page view is defined as including digital photographs selected in the image view (page 12, lines 26-28 of the specification). As defined by claim 17, which is dependent upon claim 16, the image view and page view are shown simultaneously on the video display, and the active state varies between the image view and the page view by activating one of the activating members (page 18, lines 23-29 of the specification).

As set forth in independent claim 18, the claimed invention is directed to a method for previewing and printing digital photographs on a stand-alone photoprinter. The claimed method comprises the steps of: receiving the digital photographs from a digital photograph source, wherein the digital photograph source is a computer-readable medium disposed in a drive integrated within the photoprinter; generating an image for each of the digital photographs in an image processing member; providing a user interface having a video display integrated within the photoprinter; activating an image view in the user interface to display the images on the video display; selecting from amongst the displayed images to form a printed page; activating a page view in the user interface to preview the printed page on the video display; and instructing a print control in the photoprinter to produce a pattern associated with the printed page on a print medium (page 5, lines 5-14 and page 9, lines 11-21 of the specification).

Claims 19-22 are each dependent upon claim 18 and further define the methods. In claim 19, the method further includes the steps of formatting an image in response to user instructions to the user interface and updating the display in the image view to depict the formatted image (page 10, lines 19-29 and page 11, lines 1-6 of the specification). As defined by claim 20, the method further includes the steps of formatting a printed page in response to user instructions to the user interface and updating the preview of the printed page in the page view to depict the formatted

printed page (page 16, line 26 – page 17, line 12 of the specification). In claim 21, the method is defined as including the step of moving between the image view and the page view using one or more activating members of the user interface (page 18, lines 23-29 of the specification). Claim 22 defines the method as including the step of instructing the print control to produce a pattern associated with an image displayed in the image view in response to activation of an activating member on the user interface (page 16, lines 3-25 of the specification).

VI. ISSUES ON APPEAL

The three issues presented on appeal for review by the Board are as follows:

A. The rejection of claims 1-4, 6-9, 11-13, 15-16 and 18-22 under 35 U.S.C. §102(b) as being anticipated by Levine, U.S. Patent No. 4,751,583;

B. The rejection of claims 10 and 14 under 35 U.S.C. §103 as being unpatentable over Levine in view of McCann et al., U.S. Patent No. 5,963,939; and

C. The rejection of claim 17 under 35 U.S.C. §103 as being unpatentable over Levine in view of Matsumoto et al., U.S. Patent No. 5,796,428.

VII. GROUPING OF THE CLAIMS

A. With respect to the above-noted issue A on appeal, Appellants submit that claims 1, 9, 12 and 18 are independently patentable. The reasons in support of the independent patentability of these claims are set forth below. With respect to the above-noted issue A, Appellants concede that claims 2-4, 6-8 and 11 stand or fall together with claim 1, from which they directly or indirectly depend; claims 13, 15 and 16 stand or fall together with claim 12, from which they directly or indirectly depend; and claims 19-22 stand or fall together with claim 18, from which they directly or indirectly depend.

B. With respect to the above-noted issue B on appeal, Appellants concede that claims 10 and 14 stand or fall together.

C. With respect to the above-noted issue C on appeal, only claim 17 has been rejected.

VIII. ARGUMENTS

As will be set forth in detail below, the stand-alone printing apparatus, graphical user interface for a stand-alone photoprinter, and method for previewing and printing digital photographs on a stand-alone photoprinter defined by claims 1-4 and 6-22 are not anticipated by, and are non-obvious over and patentably distinguishable from, Levine, whether alone or in combination with McCann et al. or Matsumoto et al. Accordingly, the rejection of claims 1-4 and 6-22 under 35 U.S.C. §§102 and 103 should be reversed. Favorable action by the Board is respectfully requested.

A. The Claimed Stand-Alone Printing Apparatuses, Graphical User Interfaces and Methods Are Not Anticipated By Levine

The stand-alone printing apparatuses, graphical user interfaces for a stand-alone photoprinter, and methods for previewing and printing digital photographs on a stand-alone photoprinter, as defined by claims 1-4, 6-9, 11-13, 15-16 and 18-22, are not anticipated by Levine.

1. The Invention

As set forth herein, the present invention is directed to stand-alone printing apparatuses, graphical user interface and methods for previewing and printing digital photographs on a stand-alone photoprinter. As defined by claim 1, the claimed stand-alone printing apparatuses for transferring one or more digital photographs captured by a digital device to a printable medium comprise an input member for receiving the one or more digital photographs from a source; an image processor for generating an

image corresponding to each digital photograph; an integrated graphical user interface with a video display for displaying the images and for selecting one or more of the digital photographs for a printed page; at least one drive for receiving a computer-readable medium, wherein the source is a computer-readable medium disposed in the drive; and a print control for producing on the printable medium a pattern associated with the printed page. As defined by claim 12, the claimed graphical user interface comprises a video display integrated within a photoprinter for graphically depicting an image corresponding to the digital photograph; a plurality of activating members for initiating user instructions to the user interface; and a plurality of different states in which to depict information on the video display, one of the states being active at a time, the user interface moving between active states in response to activation of one or more of the activating members. As defined by claim 18, the claimed method comprises the steps of: receiving digital photographs from a digital photograph source, wherein the digital photograph source is a computer-readable medium disposed in a drive integrated within the photoprinter; generating an image for each of the digital photographs in an image processor; providing a user interface having a video display integrated within the photoprinter; activating an image view in the user interface to display the images on the video display; selecting from amongst the displayed images to form a printed page; activating a page view in the user interface to preview the printed page on the video display; and instructing a print control in the photoprinter to produce a pattern associated with the printed page on a print medium.

In conventional printers, an external host device is utilized to preview, process and print digital files. The stand-alone printing apparatus of the present invention allows one to process and print digital files independent of an external host device. By including an integrated video display, such a stand-alone apparatus also allows for

previewing, selecting, and formatting digital photographs, for example, prior to printing. Thus, the presently claimed stand-alone printing apparatuses, graphical user interfaces for a stand-alone photoprinter, and methods provide surprising and significant cost savings and advantages for printing digital photographs.

2. The Rejection

The Examiner asserted that Levine teaches a stand-alone printing apparatus for transferring one or more digital photographs captured by a digital device to a printable medium, the printing apparatus comprising: an input member for receiving one or more digital photographs from a source; an image processor for generating an image corresponding to each digital photograph; an integrated graphical user interface with a video display for displaying the images and for selecting one or more of the digital photographs for a printed page; and a print control for producing on the printable medium a pattern associated with the printed page.

3. The Claimed Stand-Alone Printing Apparatuses, Graphical User Interfaces and Methods are Not Anticipated by Levine

The stand-alone printing apparatuses, graphical user interfaces and methods defined by claims 1-4, 6-9, 11-13, 15-16 and 18-22 are not anticipated by Levine, and the rejection of these claims under 35 U.S.C. §102 should be reversed.

Among other deficiencies, Levine fails to teach or disclose a printing apparatus that is both capable of printing digital files independent of an external host device and has an integrated graphical user interface ("GUI") for selecting one or more digital photographs for a printed page, as required by claim 1. Levine further lacks any teaching or suggestion of a graphical user interface for a stand-alone photoprinter that includes a plurality of different states in which to depict information on a video display integrated within the photoprinter, as required by claim 12. In

addition, Levine lacks any teaching or suggestion of a method for previewing and printing digital photographs on a stand-alone photoprinter that includes activating an image view in a user interface to display images on a video display integrated within the photoprinter, selecting from amongst the displayed images to form a printed page, and activating a page view in the user interface to preview the printed page on the video display integrated within the photoprinter, as required by claim 18.

More particularly, as defined by independent claim 1, the claimed stand-alone printing apparatuses include an input member for receiving one or more digital photographs from a source; an image processor for generating an image corresponding to each digital photograph; an integrated GUI with a video display for displaying the images and for selecting one or more of the digital photographs for a printed page; at least one drive for receiving a computer-readable medium, wherein the source is a computer-readable medium disposed in the drive; and a print control for producing on the printable medium a pattern associated with the printed page. As defined by the present application, and agreed to by the Examiner in the Advisory Action of July 10, 2002, a "stand-alone" printing apparatus is an apparatus that is capable of, *inter alia*, processing and printing digital files independent of an external host device, such as a computer.

Levine discloses a portable electronic still camera and image previewing and processing system, including a portable electronic camera 10 and a portable image previewer and image processor 12. Levine teaches that image processor and previewer 12 is preferably similar in configuration to laptop computers or data processors (see col. 3, lines 16-19). Accordingly, hereinafter, the image previewer and processor of Levine will be referred to as its "computer."

Levine discloses that its camera and its computer are provided as separate modular components that can be carried about in a briefcase and detachably interconnected together (see col. 2, lines 40-47). Moreover, Levine explains that its system can be advantageously used to allow for image processing in remote locations and to allow changes to be made on site (see col. 7, lines 10-38). Among other deficiencies, Appellants find no teaching or disclosure in Levine of a "stand-alone" printing apparatus that includes an integrated GUI for selecting one or more digital photographs for a printed page.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. *Atlas Power Co. v. RICO, Inc.*, 190 F.3d 1342, 1346, 51 U.S.P.Q.2d 1943, 1945-46 (Fed. Cir. 1999). Moreover, to anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, as arranged in the claim. *Carson Manufacture Corp. v. Cleveland Golf Corp.*, 242 F.3d 1376, 1383, 58 U.S.P.Q.2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Appellants find no teaching or suggestion by Levine of a stand-alone printer (i.e., a printer capable of processing and printing digital files independent of an external host device) that includes, *inter alia*, an integrated graphical user interface for selecting one or more of digital photographs for a printed page. Hence, Levine does not disclose each element of claim 1, let alone as those elements are arranged therein.

The Examiner relies on a combination of the user interface of the computer and the copier-printer 22 to assertedly arrive at the limitations of claim 1. Doing so, however, disregards the requirement of claim 1 that the printing apparatus be stand-alone (i.e., capable of processing and printing digital files independent of an external

host device). For example, the copier-printer of Levine is dependent upon its external computer for the aspect of using a GUI to select digital photographs for printing. Accordingly, with respect to using a GUI to select digital photographs for printing, the copier-printer of Levine is not stand-alone. Moreover, using both Levine's copier-printer and computer inherently contrasts with the definition of a "stand-alone" printing apparatus, and does not reflect the arrangement in claim 1. Therefore, Levine fails to teach or disclose, *inter alia*, a stand-alone printing apparatus that includes an integrated GUI for selecting one or more digital photographs for a printed page, as required by claim 1.

In addition, the only way to arrive at the invention of claim 1 would be to impermissibly use the present application as a guide for combining the copier-printer 22 and the external computer upon which it depends for the claimed GUI. Moreover, combining the devices of Levine in this way would render its system impracticable for its intended purpose. For example, since a primary goal of Levine is to allow for image processing to be performed in remote locations, combining its computer with its copier-printer, which it teaches to be in a fixed location or site, would render its image processing system unsatisfactory for portability and use in remote locations.

Accordingly, the stand-alone printing apparatuses defined by claims 1-4, 6-9, and 11 are not anticipated by Levine, and the rejection of claims 1-4, 6-9, and 11 under 35 U.S.C. §102 should be reversed.

4. The Graphical User Interface of Claim 12 is Independently Patentable

Claim 12 is independently patentable from claim 1, as are claims 13, 15 and 16 which depend from claim 12. According to claim 12, a GUI for a stand-alone photoprinter comprises: a video display integrated within the photoprinter for

graphically depicting an image corresponding to the digital photograph; a plurality of activating members for initiating user instructions to the user interface; and a plurality of different states in which to depict information on the video display, one of the states being active at a time, the user interface moving between active states in response to activation of one or more of the activating members.

The teachings of Levine have been noted above. Appellants find no teaching or disclosure by Levine of a GUI for a stand-alone photoprinter (i.e., a printer capable processing and printing digital files independent of an external host device) that includes, *inter alia*, a plurality of different states in which to depict information on a video display integrated within the photoprinter, one of the states being active at a time, the user interface moving between active states in response to activation of one or more of activating members. Levine therefore does not support a rejection of claim 12, or claims 13, 15 and 16 dependent thereon, under 35 U.S.C. §102.

More particularly, in rejecting claim 12, the Examiner relies on a combination of Levine's copier-printer and the user interface of its computer to anticipate the claimed GUI for a stand-alone photoprinter. Doing so, however, disregards the requirement of claim 12 that the GUI be for a stand-alone photoprinter (and, moreover, that the required video display be integrated within the photoprinter). For example, the copier-printer of Levine is dependent upon its external computer to provide the asserted GUI. Therefore, requiring Levine's copier-printer to include a GUI provided by its external computer necessarily means that Levine does not disclose a "stand-alone" printer with respect to that GUI. Therefore, Levine fails to teach or disclose a GUI for a stand-alone photoprinter that includes, *inter alia*, a plurality of different states in which to depict information on a video display integrated within the photoprinter, one of the states being active at a time, the user

interface moving between active states in response to activation of one or more of activating members, as required by claim 12.

As with the invention of claim 1, the only way to arrive at the invention of claim 12 would be to impermissibly use the present application as a guide for combining the copier-printer 22 and the external computer upon which it depends for the aforementioned claimed GUI. As previously discussed, combining the devices of Levine in this way would also render its system impracticable for its intended purpose.

Accordingly, the graphical user interface as defined by claim 12, and claims 13, 15 and 16 dependent thereon, are not anticipated by Levine, and the rejection of claims 12, 13, 15 and 16 under 35 U.S.C. §102 should be reversed.

5. The Method of Claim 18 is Independently Patentable

Claim 18 is independently patentable from claims 1 and 12, as are claims 19-22 which depend from claim 18. According to claim 18, a method for previewing and printing digital photographs on a stand-alone photoprinter comprises the steps of: receiving the digital photographs from a digital photograph source, wherein the digital photograph source is a computer readable medium disposed in a drive integrated within the photoprinter; generating an image for each of the digital photographs in an image processing member; providing a user interface having a video display integrated within the photoprinter; activating an image view in the user interface to display the images on the video display; selecting from amongst the displayed images to form a printed page; activating a page view in the user interface to preview the printed page on the video display; and instructing a print control in the photoprinter to produce a pattern associated with the printed page on a print medium.

The teachings of Levine are noted above. Appellants find no teaching or disclosure by Levine of a method for previewing and printing digital photographs on a stand-alone photoprinter that includes, *inter alia*, activating an image view in a user interface to display images on a video display integrated within the photoprinter; selecting from amongst the displayed images to form a printed page; and activating a page view in the user interface to preview the printed page on the video display. Thus, Levine does not support a rejection of claim 18, or claims 19-22 dependent thereon, under 35 U.S.C. §102.

More particularly, in rejecting claim 18, the Examiner relies on a combination of Levine's copier-printer and the user interface of its computer to anticipate the claimed method for previewing and printing digital photographs on a stand-alone photoprinter. Doing so, however, disregards the requirement of claim 18 that its activating and selecting steps are performed with respect to a video display integrated within a stand-alone photoprinter. For example, the copier-printer of Levine is clearly dependent upon its external computer to provide the asserted steps of the method, such as activating an image view, selecting from amongst displayed images, and activating a page view. Requiring Levine's copier-printer to include functionality provided by its external computer necessarily means that Levine does not disclose a "stand-alone" printer with respect to that functionality. Therefore, Levine fails to teach or disclose a method for previewing and processing digital photographs on a stand-alone photoprinter that includes, *inter alia*, activating an image view in a user interface to display images on a video display integrated within the photoprinter; selecting from amongst the displayed images to form a printed page; and activating a page view in the user interface to preview the printed page on the video display, as required by claim 18.

As previously discussed with respect to claims 1 and 12, the only way to arrive at the invention of claim 18 would be to impermissibly use the present application as a guide for combining the copier-printer 22 and the external computer upon which it depends for the aforementioned claimed functionality. Moreover, combining the devices of Levine in this way would render its system impracticable for its intended purpose.

Accordingly, the methods defined by claims 18, and claims 19-22 dependent thereon, are not anticipated by Levine, and the rejection of claims 18-22 under 35 U.S.C. §102 should be reversed.

6. The Stand-Alone Printing Apparatus of Claim 9 is Independently Patentable

Claim 9 is independently patentable from claim 1. According to claim 9, the stand-alone apparatus of claim 1 further requires, *inter alia*, that the user interface includes a plurality of different states, including an image view in which an image is depicted on the display, wherein activation of a print button in the image view instructs the print control to produce a pattern on the printable medium corresponding to an image on the video display. Appellants find no teaching or disclosure by Levine of such a user interface. Thus, Levine does not support a rejection of claim 9 under 35 U.S.C. §102.

The teachings of Levine are discussed above. In rejecting claim 9, the Examiner refers to "the button on the keyboard used to select printing" and cites column 7, lines 1-10. Appellants find no reference to such a button in Levine. For example, the portion of Levine cited by the Examiner only states that a composite image (which the Examiner otherwise relies on for a teaching of a page view, as opposed to an image view) can be retained in memory, and can be selected and

retrieved for read-out to its copier-printer for printing. Levine is silent on how and from where such an image is selected and retrieved.

Moreover, with respect to its asserted image view, Levine discloses that a processed image is read-out to a transfer memory where it is coded and retained for "later" retrieval (see col. 6, lines 42-57). With respect to printing such an image, Levine teaches that it can be "later" selected by its identity code for printing. In contrast, claim 9 requires activation of a print button in an image view. Therefore, Levine fails to teach or disclose the user interface required by claim 9.

Accordingly, the stand-alone printing apparatus defined by claim 9 is not anticipated by Levine, and the rejection of claim 9 under 35 U.S.C. §102 should be reversed.

B. The Claimed Stand-Alone Printing Apparatus and Graphical User Interface Are Nonobvious Over Levine In View of McCann et al.

The stand-alone printing apparatus and graphical user interface as defined by claims 10 and 14 are non-obvious over and patentably distinguishable from Levine in view of McCann et al.

1. The Invention

As set forth above, the present invention is directed to stand-alone printing apparatuses. As defined by claim 10, the claimed stand-alone printing apparatus comprises an input member for receiving the one or more digital photographs from a source; an image processor for generating an image corresponding to each digital photograph; an integrated graphical user interface with a video display for displaying the images and for selecting one or more of the digital photographs for a printed page; at least one drive for receiving a computer readable medium, wherein the source is a computer readable medium disposed in the drive; and a print control for producing on the printable medium a pattern associated with the printable page. The user interface

includes an operator panel having a plurality activating members for initiating instructions to the user interface. The video display is located on the operator panel. The user interface further includes a plurality of different states, including an image view in which an image is depicted on the display, a page view in which a page is depicted on the display, and a device view in which a representation of the printing apparatus and any attached devices is depicted on the video display. The video display varies between the different states.

As defined by claim 14, the claimed graphical user interface for a stand-alone photoprinter comprises a video display integrated within the photoprinter for graphically depicting an image corresponding to the digital photograph; a plurality of activating members for initiating user instructions to the user interface; and a plurality of different states in which to depict information on the video display. One of the states is active at a time, and the user interface moves between active states in response to activation of one or more of the activating members. The different states comprise an image view in which an image corresponding to a digital photograph is depicted on the video display, a page view in which a page comprised of selected images is depicted on the video display, and a device view in which a graphical representation of the photoprinter and any attached devices is depicted on the video display.

2. **The Rejection**

The Examiner noted that Levine does not teach the different states comprising a device view in which a graphical representation of the photoprinter and any attached devices are detected on the video display. The Examiner asserted that McCann et al. teach a display that would be used in a state of viewing devices in which a graphical representation of a printer and any attached devices are depicted on a video display.

The Examiner asserted it would have been obvious to have modified Levine to include the device view in which the graphical representation of the photoprinter and any attached devices are depicted on the video display.

3. **The Claimed Stand-Alone Printing Apparatus And Graphical User Interface Are Nonobvious Over Levine In View Of McCann et al.**

No prima facie of obviousness has been established with respect to claims 10 and 14 based upon Levine in view of McCann et al, whereby the rejection under 35 U.S.C. §103 should be reversed.

Claim 10 depends from independent claim 1 and claim 14 depends from independent claim 12. As discussed above, Levine fails to teach or disclose a printing apparatus that is both capable of printing digital files independent of an external host device and has an integrated graphical user interface ("GUI") for selecting one or more digital photographs for a printed page, as required by claim 1. Levine further lacks any teaching or suggestion of a graphical user interface for a stand-alone photoprinter that includes a plurality of different states in which to depict information on a video display integrated within the photoprinter, as required by claim 12.

McCann et al. fail to remedy the deficiencies of Levine. McCann et al. disclose an object-driven application tool which allows a value-added reseller (VAR) to access a large body of publicly available information about computing devices and to identify the needs of a particular customer or end user and to select an appropriate solution of equipment, hardware and networking products to meet the customers needs. The McCann et al. reference does not disclose or suggest the subject matter of Levine.

Accordingly, Appellants find no teaching or suggestion in Levine and McCann et al., alone or in combination, of a printing apparatus that is both capable of

printing digital files independent of an external host device and has an integrated graphical user interface ("GUI") for selecting one or more digital photographs for a printed page. Likewise, Appellants find no teaching or suggestion in Levine and McCann et al., alone or in combination, of a graphical user interface for a stand-alone photoprinter that includes a plurality of different states in which to depict information on a video display integrated within the photoprinter.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Furthermore, references relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). As Appellants find no teaching or suggestion in Levine and McCann et al. of a stand-alone printing apparatus as set forth in claim 1, or of a graphical user interface for a stand-alone photoprinter as set forth in claim 12, Levine and McCann et al. fail to provide an enabling disclosure of the stand-alone printing apparatus of claim 10 or an enabling disclosure of the graphical user interface of claim 14. Thus, as Levine and McCann et al. fail to put the claimed subject matter in the possession of the public, the combination of Levine and McCann et al. do not support a rejection under 35 U.S.C. §103.

Moreover, when a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998). To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Appellants. *In re Fine*, 837

F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Appellants find no teaching, suggestion or motivation for the combination of Levine and McCann et al. One skilled in the art would not have been motivated to combine the value-added reseller application tool of McCann et al. with a portable electronic still camera and image previewing and processing system of Levine. Hence, Appellants find no teaching, suggestion or incentive for the combination of Levine and McCann et al., and the combination of Levine and McCann et al. do not support a rejection under 35 U.S.C. §103.

Accordingly, the stand-alone printing apparatus and graphical user interfaces defined by claims 10 and 14 are nonobvious over and patentably distinguishable from Levine and McCann et al., and the rejection of claims 10 and 14 under 35 U.S.C. §103 should be reversed.

C. The Claimed Graphical User Interface is Nonobvious Over Levine in View of Matsumoto et al.

The graphical user interface as defined by claim 17 is nonobvious over and patentably distinguishable from Levine in view of Matsumoto et al.

1. The Invention

As set forth herein, the invention of claim 17 is directed to a graphical user interface for a stand-alone photoprinter. Claim 17 indirectly depends from independent claim 12. As further defined by claim 17, the graphical user interface set forth in claim 12 simultaneously shows an image view and a page view on the video display integrated within the photoprinter, wherein an active state varies between the image view and the page view by activating one of the activating members.

2. The Rejection

The Examiner noted that Levine does not teach an image view and a page view being shown simultaneously on the video display. The Examiner asserted that Matsumoto et al. teach a display image view and a page image view simultaneously on a video display. The Examiner asserted it would have been obvious to have modify Levine to include displaying the image view and the page view simultaneously on the video display.

3. **The Claimed Graphical User Interface is Nonobvious Over Levine In View of Matsumoto et al.**

No prima facie case of obviousness has been established with respect to claim 17 based on Levine in view of Matsumoto et al, whereby the rejection under 35 U.S.C. §103 should be reversed.

Claim 17 indirectly depends from independent claim 12. As defined by claim 17, the graphical user interface set forth in claim 12 simultaneously shows an image view and a page view on the video display integrated within the photoprinter, wherein an active state varies between the image view and the page view by activating one of the activating members. As discussed above, Levine lacks any teaching or suggestion of a graphical user interface for a stand-alone photoprinter that includes a plurality of different states in which to depict information on a video display integrated within the photoprinter, as required by claim 12.

Matsumoto et al. fails to remedy the deficiencies of Levine. Matsumoto et al. disclose an electronic photography system comprising an image capturing unit and a separate image storage display unit. Despite Matsumoto's teaching of an electronic photography system, Appellants find no teaching or suggestion by Levine alone or in combination with Matsumoto et al. of a graphical user interface for a stand-alone

photoprinter that includes a plurality of different states in which to depict information on a video display integrated within the photoprinter.

Moreover, Appellants find no teaching or suggestion in Levine or Matsumoto et al., whether alone or together, of simultaneously showing an image view and a page view on the video display of such a graphical user interface, let alone where an active state varies between the image view and the page view by activating one of the activating members. For example, as defined by claim 13, from which claim 17 indirectly depends, an image view is a view in which an image corresponding to a digital photograph is depicted on the video display integrated within the photoprinter. Meanwhile, claims 13 and 16, from which claim 17 also depends, defines a page view, which is a different state than the image view, to be a view in which a page, comprised of digital photographs selected in the image view, is depicted on the video display within the photoprinter.

Figures 11A, 11B and 12 of the present specification depict an image view and a page view being shown simultaneously on a video display within a photoprinter (the image view is on the left portion of the video display and the page view is on the right portion of the video display). In Figure 11A, the image view is active and depicts an image, while the page view is inactive and depicts a page where no digital photographs have yet been selected in the image view. In Figure 11B, the image view is active and depicts an image, while the page view depicts a page comprised of a digital photograph selected in the image view. Finally, in Figure 12, the page view is active and the image view, which was active in Figures 11A and 11B, is now inactive.

In rejecting claim 17, the Examiner asserted that Figure 25 of Matsumoto et al. teach an image view and page view shown simultaneously on a display. However, Appellants assert that Figure 25 of Matsumoto et al. simply discloses two page views,

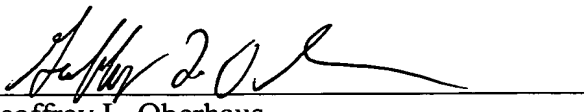
each comprising images, on a video display. For example, the item cited by the Examiner as disclosing an image view, picture 2501, is actually part of a page (shown in Figure 25 as page 1). Accordingly, picture 2501 and page 1 are not different states. Accordingly, Appellants find no teaching, disclosure or suggestion in Matsumoto et al., alone or in combination with Levine, of simultaneously showing an image view and a page view on a video display integrated within a photoprinter, wherein the active state varies between the image view and the page view by activating one of the activating members.

Thus, Levine and Matsumoto et al. do not provide an enabling disclosure of the presently claimed user interface for a photoprinter and do not place the presently claimed graphical user interface in the possession of the public, wherein the combination of Levine and Matsumoto et al. do not support a rejection under 35 U.S.C. §103. Accordingly, the user interface defined by claim 17 is nonobvious over and patentably distinguishable from the combination of Levine and Matsumoto et al., wherein the rejection of claim 17 under 35 U.S.C. §103 should be reversed.

IX. CONCLUSION

For the reasons set forth in detail above, the stand-alone printing apparatuses, graphical user interfaces for a stand-alone photoprinter, and methods for previewing and printing digital photographs on a stand-alone photoprinter as defined by claims 1-4 and 6-22 are not anticipated by, and are non-obvious over and patentably distinguishable from, Levine, whether alone or in combination with McCann et al. or Matsumoto et al. Accordingly, the rejections of claims 1-4 and 6-22 under 35 U.S.C. §§102 and 103 should be reversed. Favorable action by the Board is respectfully requested.

Respectfully submitted,



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APPENDIX

1. A stand-alone printing apparatus for transferring one or more digital photographs captured by a digital device to a printable medium, said printing apparatus comprising:

an input member for receiving said one or more digital photographs from a source;

an image processor for generating an image corresponding to each digital photograph;

an integrated graphical user interface with a video display for displaying said images and for selecting one or more of said digital photographs for a printed page;

at least one drive for receiving a computer readable medium, wherein said source is a computer readable medium disposed in said drive; and

a print control for producing on said printable medium a pattern associated with said printed page.

2. The stand-alone printing apparatus of claim 1, wherein said image processor formats said images in response to user instructions from said user interface, and said user interface updates said video display to reflect said formatted images.

3. The stand-alone printing apparatus of claim 1, wherein said user interface further comprises an operator panel having a plurality of activating members for initiating instructions to the user interface, and wherein said video display is located on said operator panel.

4. The stand-alone printing apparatus of claim 3, wherein said video display is a color liquid-crystal display.

6. The stand-alone printing apparatus of claim 3, wherein said user interface further comprises a plurality of different states, and wherein said video display varies between said different states.

7. The stand-alone printing apparatus of claim 6, wherein said different states comprise: an image view in which an image is depicted on said display, and a page view in which a page is depicted on said display.

8. The stand-alone printing apparatus of claim 7, wherein said page is comprised of one or more digital photographs selected during said image view.

9. The stand-alone printing apparatus of claim 7, wherein activation of said print button in said image view instructs said print control to produce a pattern on said printable medium corresponding to an image on said video display.

10. The stand-alone printing apparatus of claim 7, wherein said different states further comprise a device view in which a representation of said printing apparatus and any attached devices is depicted on said video display.

11. The stand-alone printing apparatus of claim 7, wherein said user interface further comprises a set of options associated with each of said different states, and

wherein said options associated with a particular state may be displayed and selected while said particular state is active on said video display.

12. A graphical user interface for a stand-alone photoprinter capable of transferring a digital photograph from a source to a printable medium, said user interface comprising:

a video display integrated within said photoprinter for graphically depicting an image corresponding to said digital photograph;

a plurality of activating members for initiating user instructions to said user interface; and

a plurality of different states in which to depict information on said video display, one of said states being active at a time, said user interface moving between active states in response to activation of one or more of said activating members.

13. The graphical user interface of claim 12, wherein said different states comprise an image view in which an image corresponding to a digital photograph is depicted on said video display, and a page view in which a page comprised of selected images is depicted on said video display.

14. The graphical user interface of claim 13, wherein said different states further comprise a device view in which a graphical representation of said photoprinter and any attached devices is depicted on said video display.

15. The graphical user interface of claim 13, wherein said user interface further comprises formatting options for formatting said digital photograph, and wherein said

user interface formats said digital photograph in response to user instructions and updates said image on said video display with a formatted image.

16. The graphical user interface of claim 13, wherein said page view is comprised of digital photographs selected in said image view.

17. The graphical user interface of claim 16, wherein said image view and said page view are shown simultaneously on said video display, and wherein the active state varies between said image view and said page view by activating one of said activating members.

18. A method for previewing and printing digital photographs on a stand-alone photoprinter comprising the steps of:

receiving said digital photographs from a digital photograph source, wherein the digital photograph source is a computer readable medium disposed in a drive integrated within said photoprinter;

generating an image for each of said digital photographs in an image processing member;

providing a user interface having a video display integrated within said photoprinter;

activating an image view in said user interface to display said images on said video display;

selecting from amongst said displayed images to form a printed page;

activating a page view in said user interface to preview said printed page on said video display; and

instructing a print control in said photoprinter to produce a pattern associated with said printed page on a print medium.

19. The method of claim 18, further comprising the steps of formatting an image in response to user instructions to said user interface, and updating said display in said image view to depict said formatted image.

20. The method of claim 18, further comprising the steps of formatting a printed page in response to user instructions to said user interface, and updating said preview of said printed page in said page view to depict said formatted printed page.

21. The method of claim 18, further comprising the step of moving between said image view and said page view using one or more activating members of said user interface.

22. The method of claim 18, further comprising the step of instructing said print control to produce a pattern associated with an image displayed in said image view in response to activation of an activating member on said user interface.

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I hereby certify that this paper is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on November 1, 2002.

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant:	Sherry A. Cook et al.	:		
Serial No.:	09/610,081	:	Group Art Unit:	2624
Filed:	July 5, 2000	:	Examiner:	K. Poon
For:	**Printer Apparatus With Integrated Graphical User Interface and Method for Using the Same**	:		

TRANSMITTAL OF APPEAL BRIEF

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

Submitted herewith in **triplicate** is an Appeal Brief in support of the Notice of Appeal filed by Certificate of Mail on July 31, 2002 and received by the U.S. Patent and Trademark Office on August 5, 2002. The government fee in the amount of $320.00 for filing the present Appeal Brief is enclosed by check.

Please charge any additional fees required or credit any excess in fees paid in connection with the present communication to Deposit Account No. 04-1133.

Respectfully submitted,

By _____

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